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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/929,398
Filing Date: August 14, 2001
Appellant(s): KRYSINSKI ET AL.

Michael L. Drapkin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/7/07 appealing from the Office action mailed 7/25/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,631,247

MOTOYAMA

10-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-14, 17-24, 26 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Tarr et al, US 5,184,179.

As per **claim 1**, Tarr et al teaches providing data capture device proximate to a business machine, the business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof (column 3, lines 24-29 – photocopier monitoring system that monitors the diagnostic signals, and upon detection of a diagnostic signal, translates the signal into a signal usable by an off site end user to determine the condition of the photocopier); automatically determining a threshold event associated with the service contract, the threshold event comprising a selection from the group consisting of a usage count for the business machine, a detected error in the business machine, a predetermined time period, and any combination thereof (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval); programming the threshold event into the data capture device, wherein the data capture device monitors the business machine to log an occurrence of the threshold event (column 3, lines 35-45

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– count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval; column 5, lines 14-30); and receiving notification from the data capture device that the threshold event was logged by the data capture device, wherein the logging of the threshold event triggers the notification (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); but does not explicitly teach reporting information related to the service contract electronically and automatically to the user based, at least in part, upon the receiving step.

Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to report contract information to the user since Tarr et al teaches reporting the contract information to a billing operator. Nothing precludes the billing operator from being a “user” and by sending this information to a user, it does not change the functionality of the system. Transmitting the contract information to the user keeps them up to date as to the status of the operational agreement.

As per **claim 2**, Tarr et al teaches a step of receiving a service call by a technician automatically generated from user input (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person).

As per **claim 3**, Tarr et al teaches a step of notifying a technician of a service call for the business machine (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the

technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 4**, Tarr et al teaches contacting the user by the technician based upon the notifying step (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person to travel to the site of the problem), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 5**, Tarr et al teaches receiving service contract information from user (column 6, lines 20-23 – the billing operator is notified when service contract termination occurs), and teaches the computer control causes a modem to transmit signals to a billing computer (column 3, lines 56-58), but does not explicitly teach the receiving of information is by way of a web interface for an operations center. It was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

As per **claim 6**, Tarr et al teaches monitoring contract termination intervals and automatically providing the appropriate service requirement in response (column 3, lines 40-47), but does not explicitly teach determining if automatic contract renewals are authorized, and

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automatically renewing the service contract if authorized. Since Tarr et al monitors usage levels and contract termination intervals, it would have been obvious to one of ordinary skill in the art to modify Tarr et al to include automatic renewal of the contract. By including automatic renewal of contracts, the service or billing personnel could ensure service would be provided to those who may have let their contract expire. In other words, the automatic contract renewal incorporated into Tarr et al would ensure appropriate service is provided to customers.

As per **claim 7**, Tarr et al teaches programming the threshold event into the data capture device from a point remote to the data capture device (column 5, lines 8-23 – the clock is set for sending a signal at a predetermined time interval).

As per **claim 8**, Tarr et al teaches the determining step is performed at a point remote to the data capture device (column 5, lines 40-44 – transfers the count information by modem to the billing computer).

As per **claim 9**, Tarr et al teaches the data capture device includes a mechanism for placing a service request when manually activated (column 8, lines 20-24 – the central station dispatches a service person).

As per **claim 10**, Tarr et al teaches the information is sent using a modem (column 5, lines 20-23), but does not explicitly teach the data capture device comprises a wireless transceiver. However, it would have been obvious at the time of the invention to include wireless transmission of the count data as a way to more efficiently receive and process information for billing purposes.

As per **claim 11**, Tarr et al teaches monitoring contract termination intervals and automatically providing the appropriate service requirement in response (column 3, lines 40-47),

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but does not explicitly teach the threshold event is one of the following: a first percentage of a contract period; and a second percentage of a contract period. However, it would have been obvious to one of ordinary skill in the art to modify Tarr et al to monitor the contract period. By modifying Tarr et al to include monitoring the contract period, setting alerts at points along the contract length, the service personnel would be aware of the status of the customer and could make appropriate offerings to the customer. For instance, if the service personnel is notified that a contract is 90% complete, the service personnel could offer a renewal as an early warning, and then when the contract is up (100% complete), the service personnel could again offer the renewal to ensure there are no lapses in the contract agreement.

As per **claim 12**, Tarr et al teaches querying the data capture device for information (column 5, lines 43-59 – as count information comes into the billing computer, a comparison is made between incoming identification information with stored identification information).

As per **claim 13**, Tarr et al teaches remotely monitoring usage of supplies; and notifying the user when ordering of supplies is predicted to be warranted (column 5, lines 60-68 – by knowing the number of copies made, a monthly total of consumed goods may be calculated – this allows the central station to maintain a consumable goods inventory – the central station then arranges for replenishment).

Tarr et al teaches the system of **claim 14** as applied to claim 1 above, but does not explicitly teach the receiving of information is by way of a web interface for an operations center. It was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of

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ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

As per **claim 17**, Tarr et al teaches a plurality of service technicians are assigned to the plurality of business machines (column 8, lines 20-55 – each service technician is dispatched to the business machine site).

As per **claim 18**, Tarr et al teaches each of the plurality of data capture device is integral to its associated business machine (column 3, lines 12-49 – the copier has a counter that displays a count value corresponding to the number of sheets of paper processed by the machine).

As per **claim 19**, Tarr et al teaches a plurality of service terminals that receive service calls for the plurality of business machines (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person to travel to the site of the problem), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 20**, Tarr et al teaches at least one of the plurality of data capture devices comprises a mechanism for requesting a service call (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person to travel to the site of the problem), but does not explicitly teach the request being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly.

It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 21**, Tarr et al teaches at least one transceiver is coupled to a data center transceiver wherein the data is transferred to the operations center using a modem (column 3, lines 50-58), but does not explicitly teach the wireless data center transceiver is coupled to a wide area network, and the wide area network is coupled to the operations center. However, it would have been obvious to one of ordinary skill in the art the time of the invention to incorporate wireless communication of a wide area network. It would have been obvious to modify Tarr et al with wireless communication over a wide area network as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 22**, Tarr et al teaches providing data capture device proximate to a business machine, the business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof (column 3, lines 24-29 – photocopier monitoring system that monitors the diagnostic signals, and upon detection of a diagnostic signal, translates the signal into a signal usable by an off site end user to determine the condition of the photocopier); automatically determining a threshold event associated with the service contract, the threshold event comprising a selection from the group consisting of a usage count for the business machine, a detected error in the business machine, a predetermined time

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period, and any combination thereof (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval); programming the threshold event into the data capture device, wherein the data capture device monitors the business machine to log an occurrence of the threshold event (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval; column 5, lines 14-30); receiving notification from the data capture device that the threshold event was logged by the data capture device, wherein the logging of the threshold event triggers the notification (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); notifying a technician to service the business machine, wherein the notifying occurs automatically in response to the notification from the capture device (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person), but does not explicitly teach the notification being performed wirelessly. It was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently.

As per **claim 23**, Tarr et al teaches reporting information related to the service contract electronically and automatically to the user based, at least in part, upon the receiving step (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval).

As per **claim 24**, Tarr et al teaches the threshold event is a malfunction in the business machine (column 7, lines 4-16 – diagnostic signal is sent if there is system failure).

As per **claim 26**, Tarr et al teaches receiving service contract information from user (column 6, lines 20-23 – the billing operator is notified when service contract termination occurs), and teaches the computer control causes a modem to transmit signals to a billing computer (column 3, lines 56-58), but does not explicitly teach the receiving of information is by way of a web interface for an operations center. It was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a web interface for communication. This would have made the communication process quicker and more efficient.

As per **claim 28**, Tarr et al teaches each capture device is coupled to an associated business machine, each associated business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, and any combination thereof (column 3, lines 24-29 – photocopier monitoring system that monitors the diagnostic signals, and upon detection of a diagnostic signal, translates the signal into a signal usable by an off site end user to determine the condition of the photocopier), each data capture device is configured to monitor its associated business machine and to log monitored events (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval; column 5, lines 14-30); and operations center in two-way communication with each of the plurality of data capture devices, wherein the operations center is configured to: determine a threshold which triggers a service to be performed by a technician pursuant to a

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service contract, the threshold comprising a selection from the group consisting of a usage count for the business machine, a predetermined time period, and any combination thereof (column 3, lines 35-45 – count signal is monitored to determine a total count based on the number of counts detected during a predetermined interval); communicates that threshold to one of the plurality of data capture devices (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); receive notification from the one data capture device that the threshold was logged by the one data capture device, triggering the notification (column 5, lines 14-30 – the billing computer automatically receives the necessary information to produce bills at a predetermined time interval); and notify the technician to service the associated business machine, wherein the wireless notifying occurs automatically in response to the notification from the data capture device (column 8, lines 20-24 – upon receipt of the diagnostic signal the central station dispatches a service person); and remote interaction with the service contract wherein users modify the threshold (column 5, lines 1-22 – clock can be set for monthly intervals, etc., wherein the usage count is determined), but does not explicitly teach wireless communication or a web interface remote to the operations center. However, it was notoriously well known at the time of the instant invention to perform communication wirelessly. It would have been obvious to modify Tarr et al with wireless communication as a way to communicate with technicians more easily, especially if the technicians were already in route. This would have ensured technicians would be notified of service calls quickly and more efficiently. In addition, it was notoriously well known at the time of the instant invention to communicate information over the Internet utilizing a web interface. It would have been obvious to one of ordinary skill in the art to modify Tarr et al to include a

web interface for communication. This would have made the communication process quicker and more efficient.

(10) Response to Argument

Appellant begins with arguments that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues that Tarr fails to teach or suggest "reporting information relating to the service contract electronically and automatically to the user based... [on] receiving" notification that a threshold event was logged by a data capture device. Appellant argues the Office Action merely appears to take Official Notice that reporting information to a user is obvious because billing information is distributed to a billing operator. Examiner points to page 5 of the Office Action mailed 7/25/07. Examiner actually states that nothing precludes the billing operator from being a "user" and by sending this information to a user, it does not change the functionality of the system.

With respect to Appellant's remarks regarding Official Notice, Appellant has failed to timely and properly traverse Examiner's notice. If Appellant fails to challenge the Examiner's notice and it is clear the Appellant has been given ample opportunity to make such challenge, the Examiner's finding will be considered conclusive. *In re Ahlert*, 424, F2d 1088, 1091, 165 USPQ

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418, 421 (CCPA 1970). To challenge the Examiner's notice, Appellant must present evidence to the contrary. Compare *In re Knapp-Monarch Co.* 296 F.2d 230, 232 132 USPQ 6, 8 (CCPA 1961) (considering challenge to taking of judicial notice by Trademark Trial and Appeal Board). In the present case, Appellant does not present any evidence or make any assertions rebutting Examiner's statements, but merely asserts that the Examiner has not provided any factual evidence.

Appellant argues that Tarr does not teach an operations center that communicates the service triggering threshold to a data capture device on a business machine. Tarr (column 6, lines 3-25) teaches programming the threshold event into a data capture device (the photocopier monitoring system is programmed to monitor end of service contract information (a threshold event) wherein at the end of a contract the billing computer is notified).

Next, Appellant argues that Tarr cannot reasonably be relied upon to teach a data capture device at a business machine with a *wireless* transceiver that transmits a notification to the operations center when the threshold is triggered. Tarr (column 6, lines 3-25) teaches a data capture device at a business machine wherein a notification is transmitted to the operations center when the threshold is triggered. Examiner asserts that it is notoriously old and well known to perform communication wirelessly. Appellant is aware this is old and well known based on the Motoyama reference cited in the office action dated 8/14/06. Motoyama (see abstract, column 5, lines 1-26) teaches a method and system for remote diagnostic, control and information collection of machines connected to a network wherein communication takes place wirelessly.

Regarding Appellant's argument that Tarr does not teach *wireless* notification of a service technician, Examiner took official notice stating it was notoriously old and well known at the time of the invention to perform communication wirelessly. Again, examiner points to Motoyama (see abstract, column 5, lines 1-26) directed to a method and system for remote diagnostic, control and information collection of machines connected to a network wherein communication takes place wirelessly.

Appellant also challenges Examiner's official notice that it was old and well known to perform information communication over the *Internet utilizing a web interface*. Appellant is aware this is old and well known based on the Motoyama reference cited in the office action dated 8/14/06. In support of Examiner's notice, See Motoyama (column 5, lines 1-26) wherein the Internet is used for communication of remote machine monitoring and control.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Johnna Loftis

Conferees:

Vincent Millin

Beth Van Doren

